

## **REMARKS**

The non-final Office Action of November 28, 2007, has been reviewed and these remarks are responsive thereto. Claims 1, 3-9, 11-21, 23-26, and 28-33 have been amended. Specifically, claim preambles have been revised and the claims have been modified to clarify and place them in a more preferred form. No new matter has been introduced. No claims have been canceled and no new claims have been added by this Amendment. Claims 1, 3-9, 11-21, 23-26, and 28-33 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

### ***Rejections Under 35 U.S.C. § 102***

Claims 1, 3-9, 11-21, 23-26 and 28-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Appl. Pub. No. 2003/0026424 (McGarrahan). Applicants traverse this rejection for at least the following reasons.

### **Claims 9, 11-15, 21, 23-26, 29, and 33**

Independent claim 9 recites a client multimedia apparatus operable to “run a software agent arranged to identify and copy portions of the primary program that have been earmarked and store a copy of said earmarked data as an associated secondary program data file.” The Office Action alleges that McGarrahan teaches this feature in paragraph [0048]. Applicants respectfully disagree. The relied-upon portion of McGarrahan relates to monitoring viewing habits of a customer by a set-top box 124, and then selecting advertisements and trailers to show based on the customer’s viewing habits. However, McGarrahan does not teach or suggest wherein any portion of a primary data program is “earmarked,” or wherein the earmarked portion of the primary data is copied and stored, as recited in claim 9. Specifically, paragraph [0048] of McGarrahan describes that the determination of which advertisement or trailer to show is made by the ‘intelligence’ feature of the set-top box 124 based on stored customer habit data, and thus is not based on identification of any earmarking of the primary program. McGarrahan also fails to disclose copying and storing portions of the primary program, but only describes storing and showing advertisements or trailers which are broadcast and received completely separately from the primary data. Thus, McGarrahan does not teach or suggest a client multimedia apparatus

operable to “run a software agent arranged to identify and copy portions of the primary program that have been earmarked and store a copy of said earmarked data as an associated secondary program data file,” as recited in claim 9. For at least the reasons stated above, Applicants submit that independent claim 9 is not anticipated by McGarrahan.

Independent claim 33 recites a client multimedia apparatus that is also operable to “run a software agent arranged to identify and copy portions of the primary program that have been earmarked and store a copy of said earmarked data as an associated secondary program data file.” Independent claims 21 and 29 are directed respectively to a method and a computer-readable media, both of which recite running “a software application so as to identify and copy earmarked portions of the stored primary program data and store a copy of the earmarked portions as associated secondary program data.” Thus, for similar reasons to those discussed above regarding claim 9, independent claims 21, 29, and 33 are not anticipated by McGarrahan.

Claims 11-15 and 23-26 depend respectively from claims 9 and 21, and are not anticipated by McGarrahan for at least the same reasons, as well as based on the additional features recited therein.

For example, claims 13 and 26 each recite wherein “the secondary program data is of a lower resolution than that of the primary program data.” The Office Action alleges (on page 5, in the rejection of claim 5) that McGarrahan discloses this feature in paragraphs [0032], [0033], and [0046]. However, the relied-upon paragraphs only describe that primary program data (e.g., movies) can be transmitted via different delivery methods and resolutions. Neither these paragraphs, nor any other portion of McGarrahan, teaches or suggests wherein secondary program data is of a different (or lower) resolution than the primary program data. Therefore, claims 13 and 26 are not anticipated by McGarrahan for at least this additional reason.

#### Claims 1, 3-8, 16-20, 28, and 30-32

Independent claim 1 recites a client multimedia apparatus operable to “provide a user interface for selection of the program data files,” and to “retrieve a secondary program data file selected by a viewer for display.” The Office Action alleges that McGarrahan teaches these features at paragraphs [0083]-[0090] and in FIG. 5, which describes a computer system for implementing McGarrahan’s techniques. Applicants disagree that these features are taught by

these sections, or anywhere else within McGarrahan. Even assuming, without conceding, that McGarrahan provides a user interface for selecting primary data (e.g., movies or games), McGarrahan neither teaches nor suggests a user interface which allows selection and retrieval of a secondary program file, as claimed. Rather, McGarrahan only discloses that advertisements or trailers are shown to the user before, after, or during a paused portion of a primary program. See paragraph [0048]. Additionally, on page 4, paragraph [0038], McGarrahan states “the set top box 124 can grab and play the content as requested and the trailers and advertisements on a predetermined schedule.” Thus, McGarrahan’s advertisements and trailers are played only according to a predetermined schedule based on the primary program requested. McGarrahan does not teach or suggest that a user can select for display a secondary program data file. Therefore, McGarrahan does not teach or suggest a client multimedia apparatus operable to “provide a user interface for selection of the program data files,” and to “retrieve a secondary program data file selected by a viewer for display,” as recited in claim 1.

Furthermore, claim 1 recites “a receiver to receive at approximately the same time primary program data and associated secondary program data from a communication channel.” In contrast, in McGarrahan, the advertisements or trailers are selected to be appropriate for the user based on customer habit data (see paragraph [0048]), and are thus associated with the user rather than with the primary program data, as recited in claim 1. Additionally, McGarrahan describes that trailers are played at the beginning, end, and in pauses of the primary movie, and it would not make sense to play a movie trailer associated with the same primary movie that is playing at that time. Thus, McGarrahan does not disclose “receiv[ing] at approximately the same time primary program data and associated secondary program data,” but instead describes receiving secondary data that is associated with the user profile.

For at least the reasons stated above, Applicants submit that independent claim 1 is not anticipated by McGarrahan.

Independent claims 16, 28, and 32 are directed respectively to a method, computer-readable media, and client multimedia apparatus, each of which recites similar features to those discussed above regarding claim 1. Thus, for similar reasons to those discussed regarding claim 1, independent claims 16, 28, and 32 are not anticipated by McGarrahan. Claims 3-8, 30, and 31 depend from claim 1, and claims 17-20 depend from claims 16, each of which are not anticipated

by McGarrahan for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

For example, claims 5 and 20 each recite “where the secondary program data is of a lower resolution than that of the primary program data.” Thus, claims 5 and 20 are not anticipated by McGarrahan for the same reasons discussed above regarding claims 13 and 26.

Additionally, claim 6 recites, “wherein the processor is operable to selectively allow marking of the primary program data for deletion or prolonged keeping upon user input during display of the secondary program data.” The Office Action alleges that McGarrahan discloses this feature in paragraphs [0056]-[0057]. These paragraphs describe a ‘Favorites GUI screen’ that allows users to mark and keep preferred content on the set-top box 124. However, McGarrahan does not teach or suggest allowing marking of primary program data “during display of the secondary program data,” as recited in claim 6. Therefore, claim 6 is not anticipated by McGarrahan for at least this additional reason.

### **Conclusion**

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants’ undersigned representative at the below-listed number.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

Dated this 28<sup>th</sup> day of February, 2008

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